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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/777,809

02/12/2004

Anthony Gordon Lewis

OSTEONICS 3.0-482

5379

530

7590

09/13/2006

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EXAMINER

FIDEI, DAVID

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/777,809	<b>Applicant(s)</b> LEWIS, ANTHONY GORDON	
	<b>Examiner</b> David T. Fidei	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 23-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 39-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                           |                                                                                         |
|-------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                               | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                      | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/6/04</u> | 6) <input type="checkbox"/> Other: ____.                                                |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-22 and 39-47 are, drawn to a display apparatus, classified in class 206, subclass 320.
  - II. Claims 23-38, drawn to a method of displaying a product, classified in class 40, subclass 427.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the apparatus can be used to transport a laptop computer that is not associated with any product nor intended to display an orthopedic device.
3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with Mr. Kevin Kocun a provisional election was made with traverse to prosecute the invention of Group I, claims 1-22, 39-47. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23-38 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Drawings***

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the U-shaped cover must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.<sup>1</sup> The drawings are also objected to because figure 3 does not show the front wall 20. In fact, figure 3 is inaccurate as cover 14 is depicted as sliding over an open front that makes it appear as though the cover forms the front wall.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

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<sup>1</sup> To avoid the issue of new matter, it is suggested the subject be deleted from the claim.

The following is suggested: Some type of reference to a “laptop” or other screen encompassing computer device should be included in the title to adequately classify and access the subject matter of the present invention.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-22 and 39-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The present invention is replete with descriptions that do not provide structural details of the features embodied thereby to such an extent that one skilled in the art would have enabled by such description. For example; page 6, lines 1 and 2 where the cover may include “additional members (not shown)”, page 7, paragraph [0024] where material is described as having a “higher coefficient” (higher than what?), page 8, paragraph [0027] a cover is envisioned to include “additional members (not shown)”, page 9, paragraph [0029] speakers are contemplated with no details set forth as to how the apparatus is constructed to properly amplify sound, reference is only made to “as known in the art”, page 10, paragraph [0031] describes a platform with “wheels” that leaves one skilled in the art subject to undue testing various constructions so that a working embodiment may be accomplished

Also, “means” is recited in the specification that fails to convey a working structural fabrication of the apparatus. Examples are paragraphs [0023], [0028], [0029], [0031] and [0032] where the means are set forth as where the word “means” creates a presumption that §112, ¶ 6 applies. *See York Prods., Inc. v. Cent. Tractor*, 99 F.3d 1568, 1574 [40 USPQ2d 1619] (Fed. Cir. 1996). However, the written description is not drafted, nor interpreted, as claims terminology.

***Claim Rejections - 35 USC § 102***

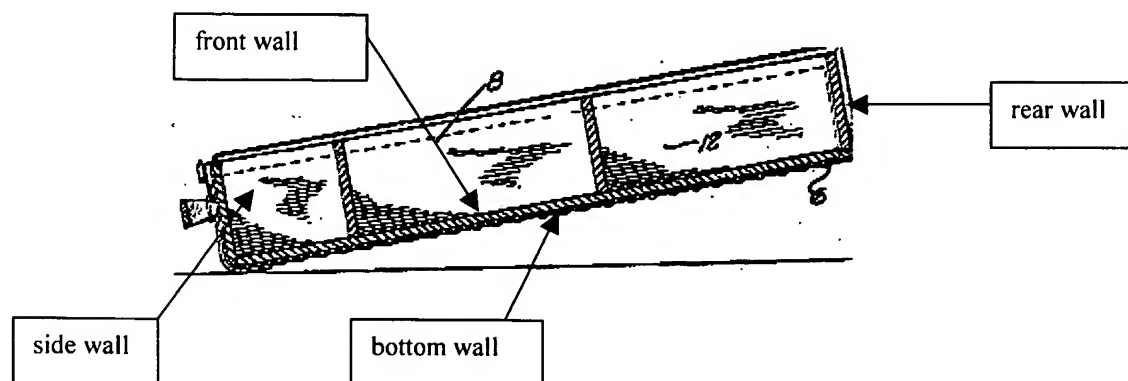
10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2, 4, 5, 7, 9-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Ritter, Jr. (US Patent no. 1,796,962). A portable display container is disclosed comprising an apparatus comprising a container 8 and a cover 7 in as much as is claimed. Any of the surfaces of section 8 comprises a surface for holding an electronic device in a much as applicant chooses to set forth.

As to claims 2, 4, 5, 7 it is a matter of convention as to what one considers a front, rear, bottom and sides walls in Ritter, Jr. As depicted below, a “front” is considered as that wall defined on the outside of section 8, the opposite side is considered the “rear wall” with the “bottom wall” defined at the right with the remaining peripheral walls defining “side walls”.



As shown above, three compartment are defined by the transverse wall extending upward from the front wall, as per claims 9-11.

As to claims 12, 14 and 15, the intended use recited is of no patentable merit.<sup>2</sup>

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<sup>2</sup> In order to further limit the claim there must be some distinction based upon the intended use recited. “However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed

As to claim 13 a latch defined by at least member 13 removably secures the cover to the container.

As to claim 16, a handle is shown in phantom in figure 3 on equivalent cover member 7.

As claims 17 and 18, a L-shaped configuration described by Ritter Jr. is considered substantially U and J shaped.

12. Claims 39-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Jung (US Patent no. 6,145,661). In figure 5 there is storage and display device including a container having a compartment "S" and a flat planar display surface 70 adjacent the compartment. As shown in figure 9 the apparatus comprising an electronic device in the form of a notebook computer (N) with a display screen at least 90 above the display surface.

As to claims 43-46, a cover 12' covers the opening of the container in a removable fashion that substantially the display surface.

As to claim 47, printed matter does not provide a sole patentable distinction over subject not novel over the prior art. In order for such "indicia" to distinguish the invention from prior art, in terms of patentability, the printed matter must be functionally related to the apparatus in order to be entitled patentable weight.<sup>3</sup> In the present case the case further comprising indicia provides no interrelationship with the apparatus.

13. Claims 1-5, 7, 9-15, 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Speirs (US Patent no. 5,857,568). A portable display apparatus is disclosed comprising a container 14 with a front wall 22, rear wall 24, bottom wall 20 and side walls 26. The top of wall 20 defines a surface for holding an electronic device. A cover 16 for removable engagement with said container includes a top 16 that covers the opening.

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invention and the prior art in order to patentably distinguish the claimed invention from the prior art, see M.P.E.P. § 2111.02

<sup>3</sup> In re John Ngai and David Lin (CAFC, 5/13/2004), NONPRECEDENTIAL OPINION ISSUED March 8, 2004, PRECEDENTIAL OPINION ISSUED May 13, 2004.

A platform 50 is slideably engaged with the apparatus which serves divide the body into at least three compartments.

Latch 46 allows for removable attachment of the cover to the container.

The intended use recitation of claim 7 and the front wall of claim 20 does not distinguish these claims over Speirs, see footnote 2. Also, the cover of Speirs includes a cover with a front wall 30, a top member 28 and a rear member 32.

14. Claims 1, 4, 5, 6, 7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Alexander (US Patent no. 5,835,344). A portable display apparatus is disclosed comprising a container 312 with a front wall 208, rear wall 214, bottom wall 216 and side walls 210, 212. The top of wall 216 defines a surface for holding an electronic device. A cover 202 for removable engagement with said container includes a top 284 that covers the opening.

As to claim 6 the intended use of the openings in wall 208 does not distinguish over the opening disclosed by Alexander.

### ***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.



4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Ritter, Jr. (US Patent no. 1,796,962) and Speirs (US Patent no. 5,857,568). Both Ritter, Jr. and Speirs discloses the claimed subject matter expect for a front wall having a thin layer of pliable material. However, Official Notice is taken that it is well known to those skilled in this art to construct brief cases and/or luggage with outer covering including a thin pliable material. It would have been obvious to one of ordinary skill in the art to modify the containers of Ritter, Jr. and/or Speirs by constructing the case body with a thin pliable material in view of Official Notice, in order to provide a aesthetic appearance to the carrier.

18. Claim 47 rejected under 35 U.S.C. 103(a) as being unpatentable over Jung (US Patent no. 6,145,661). To provide indicia on the apparatus would have been obvious and within the level of ordinary skill to one versed in this art. The motivation for such a modification would have to provide advertisement, ornamentation or aesthetic properties to the apparatus.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> Paragraph***

19. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

20. Claims 3, 19 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said body of claims 3 and 19 has no antecedent basis. Being suitable and aesthetic for display in claim 19 is of unclear scope.

***REPLY BY APPLICANT OR PATENT OWNER TO THIS OFFICE ACTION***

21. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific

distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims “define a patentable invention” without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, “The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims.” Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

If no amendments are made to claims as applicant or patent owner believes the claims are patentable without further modification, the reply must distinctly and specifically point out the supposed errors in the examiner’s action and must respond to every ground of objection and rejection in the prior Office Action in the same vain as given above, 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.


The examiner also points out, due to the change in practice as affecting final rejections, older decisions on questions of prematureness of final rejection or admission of subsequent amendments do not necessarily reflect present practice. “Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)” (emphasis mine), see MPEP 706.07(a).

### ***Conclusion***

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David T. Fider  
Primary Examiner  
Art Unit 3728

dtf  
August 29, 2006